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| Volel Emile International Business Machines Corporation Intellectual Property Law Department 11400 Burnet Road, Internal Zip 4054 Austin, TX 78758 | | | CAMPBELL, JOSHUA D | |
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/801,617

Filing Date: March 08, 2001

Appellant(s): ABDELHADI ET AL.

J. B. Kraft
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 31, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Claimed Invention*

The summary of invention contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection is correct.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

6,199,753

Tracy et al.

11-1999

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-13, 15, and 17-20 remain rejected under 35 U.S.C. 102(e) as being anticipated by Weiss et al. (hereinafter Weiss, US Patent Application Publication Number 2003/0014415, filed on February 22, 2001).

Regarding independent claim 1, Weiss discloses a method in which a user may use a web browser to select to view only a portion of a hypertext document that is linked to a hyperlink in any received hypertext document (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a method in which the portion is accessed and stored by a display station (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a method which enables the user to select and display the portion of the linked document (Page 2, paragraphs 0024-0043 of Weiss).

Regarding dependent claim 2, Weiss discloses a method in which a user may select to view the full document after viewing a portion of that document (Page 4, paragraphs 0092-0094 of Weiss).

Regarding dependent claim 3, Weiss discloses a method in which a user may select the size of the portion of the linked document to be viewed (Page 4, paragraphs 0081-0086 of Weiss).

Regarding dependent claim 4, Weiss discloses a method in which a user may use a web browser to select to view only a portion of a hypertext document that is linked to a hyperlink in any received hypertext document (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a method in which the portion is accessed and stored by a display station (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a method which enables the user to select and display the portion of the linked document (Page 2, paragraphs 0024-0043 of Weiss).

Regarding independent claim 5 and dependent claims 6-8, the claims incorporate substantially similar subject matter as claims 1-4. Thus, the claims are rejected along the same rationale as claims 1-4.

Regarding independent claim 9 and dependent claims 10-12, the claims incorporate substantially similar subject matter as claims 1-4. Thus, the claims are rejected along the same rationale as claims 1-4.

Regarding independent claim 13, Weiss discloses a method in which a user at a display station can select to view only a portion of a web page and based on that

selection the portion of the web page is accessed from the web and displayed (Page 2, paragraphs 0024-0043 and Page 9, paragraphs 0190-0195 of Weiss).

Regarding independent claim 15, the claim incorporates substantially similar subject matter as claim 13. Thus, the claim is rejected along the same rationale as claim 13.

Regarding independent claim 17, Weiss discloses a method in which a user at a display station can select to view only a portion of a web page and based on that selection the portion of the web page is accessed from the web and displayed (Page 2, paragraphs 0024-0043 and Page 9, paragraphs 0190-0195 of Weiss).

Regarding independent claim 18, the claim incorporates substantially similar subject matter as claim 17. Thus, the claim is rejected along the same rationale as claim 17.

Regarding independent claim 19, Weiss discloses a method in which a user may use a web browser to select to view only a portion of a hypertext document that is linked to a hyperlink in any received hypertext document (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a method in which the portion is accessed and stored by a display station (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a method which enables the user to select and display the portion of the linked document (Page 2, paragraphs 0024-0043 of Weiss).

Regarding independent claim 20, the claim incorporates substantially similar subject matter as claim 19. Thus, the claim is rejected along the same rationale as claim 19.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 14 and 16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. (hereinafter Weiss, US Patent Application Publication Number 2003/0014415, filed on February 22, 2001) as applied to claims 13 and 15 above, and further in view of Tracy et al. (hereinafter Tracy, US Patent Number 6,199,753, filed on November 4, 1999).

Regarding dependent claim 14, Weiss does not disclose a method in which a selected portion includes an incomplete image and that portion is accessed and

displayed in text only mode. However, Tracy discloses a method in which a web page is displayed in text only format if there is not enough view space to properly display the images of the page in their entirety (column 11, lines 12-50 of Tracy). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Weiss with the method of Tracy because it would have allowed more of the textual content to be displayed on a smaller area.

Regarding independent claim 16, the claim incorporates substantially similar subject matter as claim 14. Thus, the claim is rejected along the same rationale as claim 14.

(11) Response to Argument

Appellant's arguments filed 3/31/2005 have been fully considered but they are not persuasive.

Regarding the appellant's arguments on pages 4-6, regarding the submission of a Declaration under 37 C.F.R. 1.131 and whether or not proper conception and diligence were shown, the examiner feels that as presented in the previous rejection the Declaration is not sufficient to overcome the rejection of the claims using the Weiss reference, the reasons for this determination are restated below.

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is

more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). The statement in the appellants' declaration "The disclosure describes caching a portion of Web document which is hyperlinked to a current Web document at a receiving Web station so that the user has the option of previewing that linked Web document by popping up the cached portion," is insufficient because it fails to provide a clear explanation of the exhibit.

Even though the Declaration lacks a clear and concise explanation of the facts, in order to give the appellant the benefit of the doubt the examiner has taken it upon himself to thoroughly examine Exhibit A and feels that the evidence of conception does in fact exist in the exhibit. This knowledge was presented in the final rejection.

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The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field (February 22, 2001) of the party who was first to reduce to practice and continues until the first conceiver reduces to practice (March 8, 2001). Hull v. Davenport, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937) ("lack of diligence from the time of conception to the time immediately preceding the conception date of the second conceiver is not regarded as of importance except as it may have a bearing upon his subsequent acts"). What serves as the entry date into the field of a first reducer is dependent upon what is being relied on by the first reducer, e.g., conception plus reasonable diligence to reduction to practice (Fritsch v. Lin, 21 USPQ2d 1731, 1734 (Bd. Pat. App. & Inter. 1991), Emery v. Ronden, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974)); an actual reduction to practice or a constructive reduction to practice by the filing of either a U.S. application (Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975)) or reliance upon priority under 35 U.S.C. 119 of a foreign application (Justus v. Appenzeller, 177 USPQ 332, 339 (Bd. Pat. Inter. 1971) (chain of priorities under 35 U.S.C. 119 and 120, priority under 35 U.S.C. 119 denied for failure to supply certified copy of the foreign application during pendency of the application filed within the twelfth month)).

The evidence submitted, in both the attorney's declaration and the appellants' declaration, is insufficient to establish diligence from a date prior to the date of reduction to practice of the Weiss et al. (US Patent Application Publication Number 2003/0014415, filed on February 22, 2001) reference to either a constructive reduction to practice or an actual reduction to practice. Both the appellants' and attorney's

declarations and evidence fail to show diligence during the critical period (just prior to February 22, 2001 through March 8, 2001), instead the attorney's declaration shows evidence that predates the critical period but no evidence during the critical period, while the appellants' declaration shows no evidence at all dealing with diligence.

As it is very clearly stated in the MPEP (715.07(a)), "Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence."

The attorney for the appellant states that the application in its final draft form was completed on January 23, 2001 and the application itself was filed on March 8, 2001, no evidence of diligence is shown throughout this entire period, the examiner pointed out to the attorney in the previous rejection that only the critical period (just prior to February 22, 2001-March 8, 2001) need to be clearly shown as a period of diligence by evidence. The arguments state that "a fourteen day period is not an unreasonable one for a patent application to be processed from final draft to an executed patent application," however, the examiner feels it necessary to point out that the application existed in allegedly existed in its final draft form on January 23, 2001, which falls 44 days before the filing of the application. The examiner did state that the only period of diligence that needed to be shown was the 14 day critical period, however this statement does not warrant the assumption that the application reached its final form on exactly the first day of the critical period. Thus, it does not warrant the statement that a fourteen-day period was

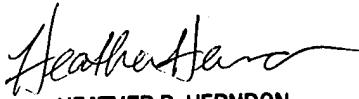
the entire processing period of the application from its final draft form to the actual filing of the application.

Regardless of the length of processing that did occur, the MPEP (paragraph 2138.06) clearly states "**An applicant must account for the entire period during which diligence is required.** Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (**statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading).** A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.)." Thus, it is clear that the Declaration is insufficient to overcome the current rejection.

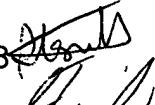
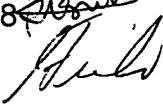
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

JDC
May 26, 2005


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